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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant:	Sagar	Examiner:	Ke, P.
Application No.:	09/780,229	Group Art Unit:	2174
Filed:	February 9, 2001	Docket No.:	US 018001
Title:	Rapid Retrieval User Interface Designed Around Small Displays and Few Buttons for Searching Long Lists		

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence and the papers, as described hereinabove, are being deposited in the United States Postal Service **in triplicate**, as first class mail, in an envelope addressed to: Mail Stop Appeal Brief – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on September 7, 2004.

By: _____
Erin M. Nichols

APPEAL BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is an Appeal Brief submitted pursuant to 37 C.F.R. § 1.192 for the above-referenced patent application. Please charge Deposit Account No. 50-0996 (VLSI.398PA) in the amount of $330 for this brief in support of appeal as indicated in 37 C.F.R. § 1.17(c). If necessary, authority is given to charge/credit deposit account 50-0996 (VLSI.398PA) any additional fees/overages in support of this filing.

I. Real Party in Interest

The real party in interest is Koninklijke Philips Electronics N.V., having a place of business at Groenewoudseweg 1, 5621 BA Eindhoven, Netherlands. The above referenced patent application is assigned to Koninklijke Philips Electronics N.V.

II. Related Appeals and Interferences

Appellant is unaware of any related appeals or interferences.

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III. Status of Claims

Claims 1-16 are presented for appeal. Claims 1-3, 5 and 8-14 are rejected under 35 U.S.C. § 102(e) over *Little et al.* (U.S. Patent No. 6,204,846); claim 4 is rejected under 35 U.S.C. § 103(a) over *Little et al.* in view of *Mugura et al.* (U.S. Patent No. 5,977,975); claim 6 is rejected under 35 U.S.C. § 103(a) over *Little et al.* in view of *Gibb et al.* (U.S. Patent No. 6,225,996); and claim 7 is rejected under 35 U.S.C. § 103(a) over *Little et al.* in view of *Xia et al.* (U.S. Patent No. 6,252,594).

Claim 15 is apparently rejected for the same reasons presented with respect to claim 7 and claim 16 is apparently rejected for the same reasons presented with respect to claim 1.

The pending claims under appeal, as presently amended, may be found in the attached Appendix of Appealed Claims.

IV. Status of Amendments

The application was initially filed on February 9, 2001, including claims 1-15. In reply to a first Office Action mailed October 6, 2003, an Office Action Response and Amendment was filed on January 5, 2004, including, *inter alia*, amendments to claims 1, 2, 8 and 10-14 and new claim 16. A final Office Action was mailed on April 5, 2004, and in reply an Office Action Response After Final was filed on May 6, 2004. A Notice of Appeal was filed on July 6, 2004.

V. Summary of Invention

One embodiment of Appellant's invention is directed to a user interface in a data processing apparatus for assisting in searching for information from an ordered list in a data array. The data processing apparatus includes an array scroller responsive to user actuation and a helper character-generator. The helper character-generator is actuated by continued user actuation of the array scroller and displays a helper character that is representative of a searching position in the list and of at least some of the information (content) corresponding to the searching position.

Another embodiment of the present invention is directed to a user interface similar to the one discussed above including the array scroller being adapted to scroll information at a speed that is responsive to user actuation.

Another embodiment of the present invention is directed to a method for enabling a user to scroll through information in an ordered list of a data array which is accessible via a data processing device. The method includes enabling the user to scroll through the list in response to the user actuating the data processing device and generating a helper character. The helper character is representative of a searching position in the list and representative of at least some of the information corresponding to the searching position.

Other embodiments are directed to software for rendering the above-discussed helper character, a service provided in a client-server configuration where the server control the display of the helper character by the client, and an information storage medium that is searched using the above-discussed helper character.

VI. Issues for Review

Issue 1: Is the Section 102(e) rejection of claim group I proper when the Examiner fails to present a reference that teaches each of the claimed limitations?

Issue 2: Is the Section 102(e) rejection of claim group III proper when the Examiner acknowledges that the cited '846 reference fails to teach each of the claimed limitations?

Issue 3: Is the Section 102(e) rejection of claim group VI proper when the Examiner fails to assert that the cited '846 reference teaches each of the claimed limitations?

Issue 4: Are the Section 103(a) rejections of claim groups II, IV and V proper when the proposed combination (modification of the '846 reference) fails to teach or suggest each of the claimed limitations?

VII. Grouping of Claims

The claims as now presented do not stand and fall together and are separately patentable for the reasons discussed in the Argument. For purposes of this appeal, the claims should be grouped as follows: Group I - claims 1-3 and 8-14; Group II – claim 4; Group III – claim 5; Group IV – claim 6; Group V – claims 7 and 15; and Group VI – claim 16.

VIII. <u>Argument</u>

The following claims are separately patentable over the other claims and claim groups for the following reasons. The claims in Group I are separately patentable over the prior art because they are directed to subject matter that includes a helper character-generator where the generated helper character is representative of both a searching position and at least some of the information corresponding to the searching position, which is not taught by the prior art. The claim in Group II is separately patentable over the prior art and the other claim groups because it is directed to subject matter that includes the helper character being used in one of a handheld device, mobile telephone, an Internet-enable device, which is not necessarily present in the other claim groups and not taught by the cited prior art. The claim in Group III is separately patentable over the prior art and the other claim groups because it is directed to subject matter that includes selecting an item from at least one of alpha-numerical characters, pictographs, letters in a name, prefixes in telephone numbers, which is not necessarily present in the other claim groups and not taught by the cited prior art. The claim in Group IV is separately patentable over the prior art and the other claim groups because it is directed to subject matter that includes a multi-dimensional list, which is not necessarily present in the other claim groups and not taught by the cited prior art. The claims in Group V are separately patentable over the prior art and the other claim groups because they are directed to subject matter that includes a helper character of at least one of audio feedback, video feedback, tactile feedback, which is not necessarily present in the other claim groups and not taught by the cited prior art. The claim in Group VI is separately patentable over the prior art and the other claim groups because it is directed to subject matter that includes an array scroller adapted to scroll information at a speed that is responsive to user actuation, which is not necessarily present in the other claim groups and not taught by the cited prior art.

Issue 1: The Section 102(e) rejection of claim group I is not proper when the Examiner fails to present a reference that teaches each of the claimed limitations.

The Examiner ignores certain limitations of Appellant's claim language and fails to cite a reference that corresponds to the claimed invention. Appellant's claimed helper character represents both the current searching position being viewed in an ordered list as well as some of the information, *i.e.*, content, of that portion of the list. The Examiner failed to address the second aspect that the helper character represents at least some of the information corresponding to the searching position, *i.e.*, content of that portion of the list. For example, in the Response to Argument section at page 7, the Examiner asserts that item 156 of the '846 Fig. 7 represents a searching position, but is silent as to how the same arrangement of numbers would correspond to representing "at least some of the information corresponding to the searching position." The claimed helper character represents both aspects of the ordered list; therefore, a *prima facie* Section 102 rejection must include correspondence to both aspects.

The Examiner fails to identify where the '846 reference teaches one helper character that corresponds to both claimed aspects of representation. The Office Action erroneously asserts that these aspects are individually taught by two different pop-up windows in the '846 reference (item 158 of Fig. 13 and item 156 of Fig. 7). The Office Action fails to allege that a single pop-up window teaches both of the claimed aspects; and therefore, fails to allege proper correspondence to the claimed invention.

Moreover, the Examiner erroneously asserts that the '846 arrangement of numbers (Showing 38-63 of 100) corresponds to both aspects of the claimed representation. The claimed helper character must represent both the searching position and information corresponding to the searching position. These are distinct limitations, both of which must be addressed in order to view the claims "as a whole." The '846 arrangement of numbers cannot correspond to both aspects of representation. The asserted arrangement of numbers does not indicate the type of data located at a particular location in a list, merely the subset being displayed, *e.g.*, item numbers 38-63. Further, the claim term "information" is used throughout the application, including the claims, to refer to the information contained in (the

content of) an ordered list. The MPEP requires that the claims be read in view of the accompanying Specification. MPEP § 2173.02. The Examiner fails to point out where the '846 reference teaches a helper character representing information corresponding to a searching position and not merely the subset of data being displayed via the location within a numbered list. Without a presentation of correspondence to each of the limitations of the claimed invention, the Section 102 rejection cannot stand. Appellant accordingly requests that the Section 102 rejection be withdrawn.

Issue 2: Is the Section 102(e) rejection of claim group III proper when the Examiner acknowledges that the cited '846 reference fails to teach each of the claimed limitations?

The Examiner acknowledges in the rejection of claim 4 that the '846 reference fails to correspond to each of the limitations of the claim of group III (claim 5). The Section 102(e) rejection of claim 5 must allege that the '846 reference corresponds to each limitation of claim 5. However, claim 5 depends from claim 4, thereby including each of the limitations of claim 4. The Examiner has acknowledged that the '846 reference fails to teach certain limitations of claim 4, such as: at least one of the following: a handheld device, a mobile telephone, an Internet-enable device with a browser. As claim 5 includes each of the limitations of claim 4 and the '846 reference fails to correspond to claim 4, the '846 reference cannot correspond to claim 5. In view of this admission by the Examiner, the Section 102(e) rejection of claim 5 is improper and cannot be maintained. Appellant respectfully requests that the rejection be withdrawn.

Issue 3: Is the Section 102(e) rejection of claim group VI proper when the Examiner fails to assert that the cited '846 reference teaches each of the claimed limitations?

The Examiner fails to assert any correspondence to various aspects of the claim of Group VI (claim 16). The Examiner rejected claim 16 "with the same rationale as claim 1." None of the rationale presented in the Office Action, including the rejection of claim 1, asserts any correspondence to limitations directed to, for example, scrolling information at a speed responsive to user actuation and a helper character-generator actuated by continued

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user actuation. Moreover, the '846 reference fails to include any discussion of the speed of scrolling. Without even an assertion of correspondence, the Section 102(e) rejection cannot be maintained and Appellant requests that the rejection be withdrawn.

Issue 4: Are the Section 103(a) rejections of claim groups II, IV and V proper when the proposed combination (modification of the '846 reference) fails to teach or suggest each of the claimed limitations?

The Examiner fails to identify how each of the proposed combinations would correspond to the claimed invention in view of the above discussed deficiencies of the '846 reference. The '846 reference fails to teach a single helper character that represents both a searching position in an ordered list and at least some of the information corresponding to the searching position. None of the Examiner's proposed modifications overcome this deficiency in the '846 reference.

Moreover, the Examiner fails to identify how the proposed modifications would correspond to the claimed invention. For example, the Examiner asserts that the '975 reference teaches a handheld device as in claim 4, but the '975 reference teaches an alternative method of enabling manipulation of the graphic images on the handheld display screen. The Examiner fails to explain how '975 manipulation method would be implemented with the '846 method of viewing a subset of data. With respect to claim 6, the Examiner fails to explain how the '996 large, vertically and horizontally scrolled spread sheet would fit on the user interface of the claimed invention. With respect to claims 7 and 15, the Examiner fails to identify a helper character separate from the array scroller. The '594 reference merely teaches a scroller and not a helper character, as claimed. The Examiner failed to present references that alone or combined correspond to the claimed invention. Thus, the Section 103(a) rejections are improper and cannot be maintained. Appellant requests that each of the rejections be withdrawn.

IX. Conclusion

In view of the above, Appellant submits that the rejections are improper, the claimed invention is patentable, and that the rejections of claims 1-16 should be reversed. Appellant respectfully requests reversal of the rejections as applied to the appealed claims and allowance of the entire application.

Authority to charge the undersigned's deposit account was provided on the first page of this brief.

Should there be any remaining issues that could be addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Mr. Peter Zawilski, of Philips Corporation at (408) 474-9063.

Please direct all correspondence to:

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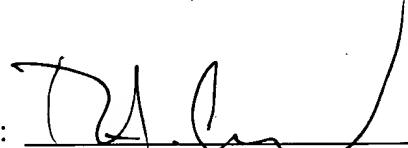
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APPENDIX OF APPEALED CLAIMS

1. (previously presented) A data processing apparatus having a user interface assisting in searching for information from an ordered list in a data array, the apparatus comprising:

an array scroller responsive to user actuation; and

a helper character-generator, actuated by continued user actuation of the array scroller, the helper character generator being operative to display a helper character representative of a searching position in the list and of at least some of the information corresponding to the searching position.

2. (previously presented) The data processing apparatus of claim 1 wherein,

the helper character shows additional helper characters by deactivating the array scroller, then reactivating the array scroller.

3. (original) The computing apparatus of claim 1 wherein,

the helper character display corresponds to a location on a GUI display.

4. (original) The apparatus of claim 1, comprising at least one of the following: a handheld device, a mobile telephone, an Internet-enable device with a browser.

5. (original) The apparatus of claim 4 wherein the item is selected from at least one of the following: alpha-numerical characters, pictographs, letters in a name, prefixes in telephone numbers.

6. (original) The apparatus of claim 1 wherein the list is multi-dimensional.

7. (original) The apparatus of claim 1 wherein the helper character-generator renders a helper character comprising at least one of the following: audio feedback, video feedback, tactile feedback.

8. (previously presented) In a data processing environment, a method for enabling a user to scroll through information in an ordered list in a data array accessible through a data processing device, the method comprising:

    enabling the user to scroll through the list, in response to the user actuating the data processing device; and

    generating a helper character representative of a searching position in the list and of at least some of the information corresponding to the searching position;.

9. (original) The method of claim 8, wherein the data processing environment comprises a distributed environment.

10. (previously presented) Software for being installed on an information processing apparatus, wherein the software renders the apparatus operative to display a helper character representative of a searching position of an ordered list and of at least some of the information corresponding to the searching position currently being scrolled in response to a user interacting with the apparatus.

11. (previously presented) A service supplied in a client-server configuration, wherein:

the server provides user-access to an ordered list of information items; and

the client is enabled to interact with the server, the server controlling the client to display a helper character representative of a searching position of the list and of at least some of the information corresponding to the searching position currently being searched at the client.

12. (previously presented) The service of claim 11,

wherein, the client comprises at least one of the following: a handheld device, a desktop computer, a laptop computer, a wireless telephone handset, a portable media-playing device, and a cell phone.

13. (previously presented) An information storage medium comprising:

an ordered list of information items;

at least one respective helper character corresponding with and representative of a searching position in the list and of at least some of the information corresponding to the searching position; and

control software for controlling a rendering of a specific one of the helper characters during the scrolling of the corresponding one of the items.

14. (previously presented) The information storage medium of claim13 wherein the ordered list comprises at least one of the following: a sequence of alpha-numeric characters, a sequence of pictographs, a sequence of images, a sequence of sounds.

15. (original) The information storage medium of claim 14 wherein the rendering of a

specific one of the helper characters comprises at least one of the following: audio

feedback, video feedback, tactile feedback.

16. (previously presented) A data processing apparatus having a user interface assisting

in searching for information from an ordered list in a data array, the apparatus

comprising:

an array scroller adapted to scroll the information at a speed that is responsive to

user actuation; and

a helper character-generator, actuated by continued user actuation of the array

scroller, the helper character generator being operative to display a helper character that

represents a scrolling position in the list and at least some of the information

corresponding to the scrolling position.